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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,917	06/10/1999	CARLOS CORDON-CARDO	55293-B/JPW/	8767

7590 12/20/2001

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EXAMINER

SOUAYA, JEHANNE E

ART UNIT	PAPER NUMBER
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1655

11

DATE MAILED: 12/20/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/329,917

Applicant(s)
Cordon-Cardo

Examiner
Jehanne Souaya

Art Unit
1655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 5, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-8 is/are pending in the application.
- 4a) Of the above, claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

1. Currently, claims 1-3 and 6-8 are pending in the instant application. Claims 6-8 are withdrawn from consideration as being drawn to a non-elected invention. The rejection of claims 1-3 under 35 USC 112/first paragraph has been withdrawn in light of the amendments to the claims. The following rejections are newly applied, necessitated by amendment. They constitute the complete set being presently applied to the instant Application. This action is FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al. (US Patent 6,316,208; 102 (e) date: 2/7/1997).

Newly amended claim 1 is drawn to the likelihood that a prostate carcinoma is aggressive comprising comparing the amount of p27 protein expressed in a sample of prostate carcinoma to the amount of p27 protein expressed in a normal prostate sample, a decreased amount of p27 in

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the prostate carcinoma sample relative to the normal prostate sample indicating the likelihood that the prostate carcinoma is aggressive. Roberts teaches a method for evaluating a cancer patient's prognosis comprising ascertaining the level of human p27 protein (SEQ ID NO 2) in a sample of cancer cells from the patient and comparing the level with wild-type p27 protein in normal control samples wherein a reduced level of the p27 protein in the sample correlates with an increased risk for recurrence of a cancer 9 (see claim 3). Roberts further teaches that the cancer can be a carcinoma (claim 9) and more specifically a carcinoma of a tissue from prostate (claim 10). It is noted that a measurement of the aggressiveness of a carcinoma is whether there is a recurrence of cancer, a recurring cancer being indicative of aggressiveness. Therefore, the teachings of Roberts as to a decrease in p27 protein from a prostate cancer relative to a normal control being correlated with an increased risk for recurrence of cancer, anticipates the instantly claimed invention of determining the likelihood that a prostate carcinoma is aggressive by comparing p27 protein levels in a sample of the prostate carcinoma to the level of p27 protein in a normal control, the decreased level of p27 protein in the prostate carcinoma being indicative of a likelihood that the prostate carcinoma is aggressive.

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Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


5. Claims 2 and 3 appear to be free of the prior art.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Friday from 9:00 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600



Jehanne Souaya
Patent examiner
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Dec. 13, 2001